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8 WONDERFUL COMPANY LLC

9  
10 **UNITED STATES DISTRICT COURT**  
11 **CENTRAL DISTRICT OF CALIFORNIA, WESTERN DIVISION**  
12

13 POM WONDERFUL LLC, a Delaware  
limited liability company, and THE  
14 WONDERFUL COMPANY LLC

15 Plaintiffs,

16 vs.

17 ROBERT G. HUBBARD d/b/a PUR  
BEVERAGES, PORTLAND  
18 BOTTLING COMPANY an Oregonian  
company, and DOES 1 through 10,  
19 inclusive,

20 Defendants.  
21  
22  
23

24 AND RELATED COUNTERCLAIM.  
25  
26  
27  
28

Case No. CV13-06917-RGK (JPRx)

**PLAINTIFFS' OPPOSITION TO  
ROBERT G. HUBBARD'S MOTION  
FOR PARTIAL SUMMARY  
JUDGMENT BASED ON  
ABANDONMENT OF  
REGISTRATION NO. 2637053**

[Declaration of Michael Vasseghi,  
Response to Hubbard's Separate Statement  
and Statement of Additional Material  
Facts, filed concurrently herewith]

Date: June 20, 2016

Time: 9:00 a.m.

Ctrm: 850

**[Hon. R. Garv Klausner]**

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## 1 I. INTRODUCTION

2 Hubbard's motion is premised on the following incorrect theory: Pom  
3 Wonderful owns a registration for the standard character trademark, POM. POM  
4 Wonderful does not use POM but rather **POM** on its products. Therefore, because  
5 Pom Wonderful does not use POM, but **POM**, that amounts to non-use and  
6 abandonment of its POM mark, allowing Hubbard to use pöm on his beverage.

7 The Ninth Circuit in this case, as well as opinions from the Trademark Trial  
8 and Appeal Board ("TTAB") of the United States Patent and Trademark Office  
9 ("USPTO") and actions by the USPTO completely disembowel Hubbard's  
10 abandonment theory. The Ninth Circuit has held in this case that POM Wonderful  
11 has exclusive rights to use POM in any manner because that mark "covers all design  
12 variations of the word" since it was registered as a standard character mark. The  
13 USPTO has also found, repeatedly, that POM Wonderful's use of **POM** on its  
14 product is a proper use of its standard character mark: POM. Notably, Hubbard's  
15 motion does not cite to a single case or authority, where a court or the TTAB has  
16 cancelled a mark for abandonment because the mark's use in commerce did not  
17 precisely match the standard character mark on the register. That is because no such  
18 case exists. To the contrary, trademark owners routinely use their trademarks with  
19 some wort of design on their products (**POM**) while holding registrations for just the  
20 standard character word mark (POM).

21 Trademark protection policy and USPTO regulations not only allow, but  
22 expect variations between a registered standard character word mark and how that  
23 trademark appears on a product. So long as the mark as used in commerce does not  
24 create an "uncommon or special commercial impression" from the standard  
25 character mark, this variation is acceptable. When the proper legal standard is  
26 applied, **POM** does not create an uncommon or special impression of POM.  
27 Trademark owners such as Coca-Cola and Rockstar Energy Drinks, routinely place  
28 design elements on their products not found on their registered standard character

word mark. Yet, their trademark registrations are not considered abandoned due to non-use. Furthermore, the USPTO accepts those companies' specimens showing the mark used with a design even though the corresponding trademark registration is for the standard character word mark.

Hubbard's reliance on decisions by the TTAB for the proposition that use of a design in a standard character mark is "prohibited", completely misses the mark. First, those cases do not stand for the proposition Hubbard asserts. Second, those cases have nothing to do with abandonment of trademarks but rather what constitutes likelihood of confusion between marks for purposes of registration before the USPTO.

Finally, Hubbard has created triable issues of material fact by arguing that POM Wonderful's use of its POM mark on its websites is not proper trademark use. The facts and the law pertaining to what constitutes proper trademark use on a website, establish that those uses, do in fact, constitute proper trademark use.

For these reasons and those set forth below, not only should Hubbard's motion be denied, but POM Wonderful's Motion for Summary Judgment on this issue and others should be granted.

## II. ARGUMENT

### A. POM Wonderful Never Abandoned The POM® Trademark As a Matter of Law

Hubbard's motion is premised on the theory that POM Wonderful uses a stylized "O" (or as he wrongly calls it a "design element"<sup>1</sup>) in the POM mark such

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<sup>1</sup> The distinction is worth noting. Hubbard calls the heart a "design element" instead of a stylized "o" intentionally, to avoid admitting that it is read, spoken and written as "pom", the same mark as his infringing mark: pōm. However, the trademark is not registered as p-heart-m. Instead, the trademark registration specifically describes the mark this way: "The mark contains *the word POM* with *a heart design in place of the letter 'O'*". See, Reg. No. 3047447 for **POM** attached as Exhibit A to the Declaration of Michael Vasseghi, ("Vasseghi Decl.").

1 that it is written in the form **POM** on its products. Therefore, Hubbard argues POM  
 2 Wonderful no longer uses the POM mark which he claims amounts to its  
 3 abandonment. Decisions from both the USPTO as well as from the Ninth Circuit  
 4 completely undermine Hubbard's counter-claim<sup>2</sup>/affirmative defense of  
 5 abandonment. Specifically, the Ninth Circuit in *this* case has held:

6 Importantly, Pom Wonderful's exclusive right to use the "POM®" mark  
 7 ***covers all design variations of the word*** because "POM®" was registered as a  
 8 standard character mark. Standard character registrations "are federal mark  
 9 registrations that make no claim to any particular font style, color, or size of  
 10 display." *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349  
 11 (Fed.Cir. 2011). Because a word registered in standard characters is "not  
 12 limited to any particular rendition of the mark," *In re Mighty Leaf Tea*, 601  
 13 F.3d 1342, 1348 (Fed. Cir. 2010) (internal quotation marks omitted), the  
 14 registration covers the word per se, 3 McCarthy on Trademarks and Unfair  
 15 Competition § 19:58 (4th ed.) (updated Sept. 2014). ***Therefore, Pom  
 16 Wonderful's exclusive right to use its "POM" standard character mark is  
 17 extremely broad, covering the word in all types of depictions.***  
 18 *Pom Wonderful v. Hubbard*, 775 F.3d 1118 at 1125 (9<sup>th</sup> Cir. 2014) (emphasis  
 19 added).

20 Here, POM Wonderful's use of **POM** is a design variation of the POM  
 21 trademark, just as the registration describes (see footnote 1) and therefore an  
 22 accepted use of POM.

### 23 1. The USPTO Has Accepted POM's Specimen of Use

24 The USPTO – the authority charged with granting trademark registrations and  
 25 ruling on whether a trademark is valid or abandoned - has determined that **POM** is a  
 26 proper and valid use of POM. The USPTO requires proof of use of a trademark in  
 27 order to maintain its registration. To comply with this requirement, a trademark  
 28 owner must submit a "specimen of use" (evidence of use) to the USPTO. The

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<sup>2</sup> Hubbard's counter-claim for abandonment, filed without leave of court on May 6, 2016, is not yet at issue. POM Wonderful's motion to dismiss that counter-claim (among others), is set for hearing on June 27<sup>th</sup>.

1 purpose of a specimen is “to show the mark as it is actually used.” *Marshall Field*  
 2 & *Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355, \*4 (TTAB 1989). Most trademark  
 3 owners provide a photo of the product bearing the registered mark. POM  
 4 Wonderful has complied with this accepted practice. For many years, POM  
 5 Wonderful has submitted an image of its product – which has always had POM on  
 6 the bottle - as a specimen for, and proof of use of, the POM trademark. (Additional  
 7 Statement Of Undisputed Material Fact (“ASUMF”) No. 1.)

8 Since the POM mark has been continuously used in its POM form since  
 9 inception of the company, it cannot be abandoned since abandonment is based on  
 10 non-use of a mark. *Imperial Tobacco Ltd., v. Philip Morris, Inc.*, 899 F.2d 1575,  
 11 1577 (Fed. Cir. 1990). The USPTO has never rejected POM Wonderful’s specimen  
 12 of use as being insufficient for, or improper use of, or not constituting use of the  
 13 standard character word mark POM. The reason for this is simple. As the Ninth  
 14 Circuit explained in this case, because POM Wonderful has a registered trademark  
 15 for the POM mark, that right allows it to use the mark in “all design variations” and  
 16 in “all types of depictions”. POM is inherently a depiction of POM and a specimen  
 17 showing use of POM inherently includes the use of POM as a matter of law.

## 18 2. The Stylized “O”/Heart Design Does Not Create An 19 Uncommon Or Special Commercial Impression

20 Hubbard argues that because POM Wonderful uses a heart in its “O” – which  
 21 is a design and not found on the USPTO’s “Standard Character Set”<sup>3</sup>, “there can be  
 22 no question that the heart design element in POM engenders an uncommon or  
 23 ‘special’ commercial impression.” (Motion 9:4-6). Hubbard then concludes that,  
 24 because the heart creates a special commercial impression, its use does not  
 25 constitute the use of POM. It is apparent that Hubbard does not know what  
 26

27  
 28 <sup>3</sup> The Standard Character Set is attached as Exhibit O to Hubbard’s Request for  
 Judicial Notice filed in support of his motion [Docket No. 163-15].



1 constitutes “an uncommon or special commercial impression.” Uncommon/special  
 2 commercial impressions have nothing to do with the existence of any design  
 3 element or whether any portion of the mark is or is not found in the USPTO’s  
 4 Standard Character Set.

5 Two cases from the USPTO, one of which was cited by Hubbard, explain this  
 6 concept. In the first case, United Services filed an application for the word mark  
 7 “FOR LIFE INSURANCE SEE US”. *In re United Services Life Insurance*  
 8 *Company*, 181 USPQ 655 (TTAB 1973). However, in the specimen (proof) of use,  
 9 the mark was shown in the following manner:

10 ***for life insurance see US***  
 11

12 The Board refused registration of the mark because the specimen showed the “US”  
 13 portion of the mark in larger lettering and underlined, suggesting a double entendre  
 14 because “US” could stand for applicant’s name “United Services” or for the pronoun  
 15 “us”. *Id.* at \*1. If viewed as the pronoun “us”, it “may be devoid of the capability  
 16 of identifying and distinguishing the life insurance services of any one particular  
 17 company” thereby becoming an “unregistrable mark[] and slogan[]” *Id.* at \*1. Due  
 18 to this uncommon and unique commercial impression, registration was refused.  
 19 Notably, the presence or absence of a design element was not relevant to the inquiry.

20 Likewise in *In re Morton Norwich Products, Inc.*, 221 USPQ 1023 (TTAB  
 21 1983), a case Hubbard also cites, applicant sought to register the mark “LABID” for  
 22 pharmaceutical preparations for illnesses related to asthma and lung disorders. *Id.* at  
 23 \*1. However, in the specimen of use, the mark was in the following form:

24 **LABID**  
 25

26 The TTAB refused registration of the mark because the letter “a” is smaller  
 27 lettering with a diacritical accent that sets off the “BID” portion of the mark. The  
 28 problem was that the term “BID” had an accepted meaning as applied to drug



1 prescriptions, i.e. “twice a day”. *Id.* However, the directions for use on the drug  
 2 was *one or two* tablets every twelve hours. *Id.* Therefore the applied for trademark  
 3 was inconsistent with the range of recommended dosage for this drug, thus creating  
 4 a special/uncommon impression. Notably, every letter and the diacritical mark  
 5 above the “a” is found on the Standard Character Set. Therefore whether a mark  
 6 creates an uncommon or special commercial impression hinges on issues beyond  
 7 any design incorporation in the mark.

### 8                   3.     **Hubbard Confuses The Requirements for Proper Trademark** 9                             **Application With Proper Use of a Standard Character Mark**                               **in Commerce**

#### 10                             (a)   **The Standard Character Set Is For The USPTO’s** 11                                       **Administrative Purposes Of Ensuring Proper Mark**                                       **Classification**

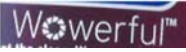






12           As best as POM Wonderful can tell, Hubbard argues the following: POM is a  
 13 standard character mark. The USPTO’s Standard Character Set provides what  
 14 symbols, letters, and diacritical marks can be used in a standard character mark  
 15 registration. Since a heart is not found in the Standard Character Set (the “Set”), it  
 16 cannot be used as part of a standard character mark, and use of the heart on POM  
 17 Wonderful’s products amounts to no use of the POM mark, resulting in  
 18 abandonment.

19           Hubbard is either completely confused or this is a red herring argument  
 20 designed to confuse this court. The Set has *nothing* to do with how a mark may be  
 21 *used in commerce*.

22           The USPTO’s Set only governs how an Examining Attorney at the USPTO  
 23 treats *the drawing of the mark* that is submitted with the application for registration  
 24 in evaluating whether the drawing matches the claims made in the application itself.  
 25 For instance, if you claim rights to the standard character mark in your application,  
 26 but your drawing includes more than just standard characters in it, the Examining  
 27 Attorney will require a correction of one or the other. The standard characters the  
 28 Examining Attorney looks at are those in the Set. As the Examination Guide

1 explains, “if the drawing includes elements that are not in the set, the examining  
2 attorney must treat the drawing as a special form drawing and require applicant to  
3 delete the standard character claim.” (Examination Guide 1-03 Section I.A.2 (page  
4 2/9) attached as Exhibit B to Vasseghi Decl.) By way of example, if POM  
5 Wonderful, had submitted **POM** as a standard character drawing, the Examining  
6 Attorney would have required a correction of either the application or the drawing,  
7 because the heart design in **POM** is not in the Set, as Hubbard correctly points out.  
8 However, the Set is only relevant to the proper description of a mark (e.g., “standard  
9 character” mark versus, “word plus design” mark versus “design” mark etc.). The  
10 Set is simply a trademark application/drawing examination tool and has absolutely  
11 nothing to do with what qualifies as a proper use of the mark in commerce.  
12 Hubbard offers no authority to the contrary.

13 **(b) Standard Character Marks Are Routinely Used In**  
14 **Commerce With Design Elements**

15 The Ninth Circuit found that the POM standard character mark can be used in  
16 “all design variations” and in “all types of depictions.” *Pom Wonderful, supra*, at  
17 1125. This is not surprising as there are numerous examples of marks that are  
18 registered as a standard character mark, but their actual use in commerce varies  
19 slightly. The use of a design in lieu of a letter, especially the letter “O”, in  
20 trademarks registered as standard character marks is not unique or even uncommon.  
21 A fifteen minute search on the USPTO’s website reveals several examples of marks  
22 that are registered as a standard character mark, but their use in commerce has a  
23 design element in the letter “O”. For example WOWERFUL is  
24 used as , TROMAX as , REVOX as , IROAR as  
25 , PRO YO as , SOS as , and CORE COMMUNICATIONS as  
26 . These marks are all registered as standard character trademarks *but*  
27 *specimens showing the mark used with a design are proof of use of the standard*  
28 *character mark.* (See Exhibit C to Vasseghi Decl.). As evidenced here, all but one

1 of these marks are also separately registered with the design element in the “O.”  
2 (Exhibit D to Vasseghi Decl.). This is how trademark owners protect their marks.

3 The common practice and purpose of registering a mark both as a standard  
4 character mark (POM) and also with a design element (POM) is, in part, to ensure  
5 that an infringer, like Hubbard, cannot argue (as he does in this case), that a slight  
6 variation (like his breve above the o as pöm instead of a stylized “O” (POM)), even  
7 if the mark is otherwise identical, eliminates the infringement. Clearly, that cannot  
8 be the case otherwise the policy behind trademark law which would be eviscerated.  
9 This is exactly why the Ninth Circuit held that POM Wonderful’s “exclusive right to  
10 use the “POM” mark *covers all design variations* of the word because ‘POM®’ was  
11 registered as a standard character mark.” *Pom Wonderful, supra*, at 1125 (9<sup>th</sup> Cir.  
12 2014) (emphasis added).

13 Hubbard claims that “[t]he rights conferred by registration of standard  
14 character marks [sic] extend to the mark in a variety of forms and styles, including  
15 different fonts and colors. They *do not* extend to include protection of those words  
16 combined with a design element.” (Motion 6:26-28) (italics in original). According  
17 to Hubbard such designs are “prohibited in a standard character mark” and therefore  
18 the standard character mark is somehow abandoned. (*See* Motion 6:22).

19 First, Hubbard uses the word “design” intentionally, again, to avoid calling it  
20 what it is, a stylized “o” in the term “pom”.

21 Second, apparently Hubbard thinks he knows better than the Ninth Circuit  
22 which held *exactly the opposite* when it stated that the POM mark “covers all design  
23 variations” of the word, and offers no authority for this position.

24 Third, Hubbard’s theory runs counter to the practice of trademark policing,  
25 trademark enforcement, and well-established trademark law, including the Ninth  
26 Circuit’s holding in this case.

27 Hubbard claims that “[t]he fact that Pom Wonderful separately registered  
28 POM as a design mark is an admission that Pom Wonderful understands the standard

1 character mark does not extend to protection of the heart design element. Thus use  
2 of **POM** does not constitute use of the ‘POM®’ standard character mark.” (Motion  
3 10:17-21). Hubbard has it backwards. If, for example, POM Wonderful only had a  
4 registration for **POM**, a potential infringer might use: **POM** or POM, and claim that  
5 its infringing mark is not similar to **POM**. However, that infringer cannot make that  
6 argument when the standard character POM mark is also registered and, particularly  
7 in this case, where the standard character mark is encompassed within the mark  
8 containing the stylization of a letter. And that is why companies regularly register  
9 their marks not only as word marks, but also with any specific designs or  
10 stylizations within the letters in those words. Indeed, that is precisely why **POM** *does*  
11 constitute use of POM. The POM registration is “extremely broad, covering the  
12 word in all types of depictions.” *Pom Wonderful v. Hubbard* at 1125. If POM is  
13 covered “in all types of depictions”, how can **POM** not be such a depiction? It is.  
14 What Hubbard considers abandonment, is actually common trademark and brand  
15 protection practice, implemented by any company worth their salt.

16 **B. Specimens Can Contain Design Elements And Still Be Proper Use**  
17 **of The Standard Character Mark**

18 If Hubbard’s abandonment theory was correct, then every trademark owner  
19 who uses their standard character mark with some design element in the market  
20 place, has abandoned their trademark. According to Hubbard, none of the marks  
21 above - TROMAX, WOWERFUL, REVOX, IROAR, PRO YO, SOS, CORE  
22 COMMUNICATIONS - are in use because they are all used with a design in the  
23 “O”, and therefore their standard character marks have been abandoned. That is not  
24 how trademark law works.

25 Well-known brands such as Coca-Cola, Rock Star Energy Drink, and a host  
26 of other companies have abandoned their trademarks if Hubbard’s interpretation of  
27 the law is applied. Like Pom Wonderful, Coca-Cola has a registered trademark for  
28 the standard character mark: “COCA-COLA.” (*See* Exhibit E to Vasseghi Decl.)

1 And like POM Wonderful, Coca-Cola also has a registration for:



2  
3  
4  
5  
6  
7 (See Exhibit F to Vasseghi Decl.). Rock Star Energy Drink has a star in place of the  
8 "A" on its product:



9  
10  
11  
12 Yet this trademark *is only registered as a standard character word mark* "ROCK  
13 STAR ENERGY DRINK" for beverages.<sup>4</sup> And the specimen of use for this  
14 standard character mark contains the star like the image above, in place of the letter  
15 "A" - just like the marks TROMAX, WOWERFUL etc., above. (See Exhibit G,  
16 page 57 to Vasseghi Decl.)

17 None of these designs as described and used by Coca-Cola or Rockstar are  
18 found in the USPTO's Standard Character Set, but rather, are designs with design  
19 codes. (See Coca-Cola's registration attached as Exhibit F to Vasseghi Decl. and  
20 Rockstar's registration page attached as Exhibit H to Vasseghi Decl.).

21 According to Hubbard, since Coca-Cola uses the above "word plus design"  
22 mark on its product, and Rockstar uses a star design in place of its "A" on its  
23 product, these companies have abandoned their rights in their standard character  
24 marks "COCA-COLA" and "ROCKSTAR ENERGY DRINK", because those  
25 marks contain design elements or stylization when used in commerce. These two  
26 \_\_\_\_\_

27 <sup>4</sup> Rockstar does have a registration for its mark with star in place of the letter "A"  
28 for goods such as luggage and bags, but not for beverages. (See Exhibit H to  
Vasseghi Decl.)

1 examples highlight the absurdity of Hubbard's abandonment theory.

2 **C. Trademark Trial and Appeal Board Authority Undermines**  
3 **Hubbard's Abandonment Theory**

4 Opinions by the TTAB, the USPTO's internal appeal board, on this very issue  
5 are consistent with the Ninth Circuit's holding in this case. *In re wTe Corporation*,  
6 87 USPQ2d 1536 (TTAB 2008) illustrates how a trademark as registered, versus, as  
7 it is actually used in commerce, can vary yet still constitute appropriate use. In *In re*  
8 *wTe Corporation* applicant sought to register the standard character mark for  
9 SPECTRAMET. In the specimen provided for the registration, the letter "c" was  
10 replaced with the following double arrow design: **Spe~~o~~tramet**. The Examining  
11 Attorney refused the registration on the grounds that SPECTRAMET was not the  
12 same as **Spe~~o~~tramet** since the "c" in the specimen was not a "c" but a double arrow  
13 design. Applicant appealed to the TTAB, arguing that "there is no corresponding  
14 requirement that, however, that [*sic*] the commercial use of the mark should match  
15 the same generic typed form." *Id.* at \*2. The TTAB agreed with applicant, reversed  
16 the Examiner's decision, and held that **Spe~~o~~tramet** was an acceptable specimen and  
17 use for the SPECTRAMET typed drawing mark.

18 The legal standard by which the TTAB decides whether SPECTRAMET and  
19 **Spe~~o~~tramet** or POM and **POM** are the same for trademark use, is if they are "the  
20 same in essence and is recognizable regardless of the form or manner of display."  
21 *In re wTe Corporation* at \*2, and whether the marks create the same commercial  
22 impression. "[T]he arrow design is not a very significant element and the mark in  
23 the drawing and the specimens remain 'in essence the same'". *In re wTe*  
24 *Corporation* at \*2. "There would be little reason for consumers to view the mark as  
25 displayed on the specimen as anything other than SPECTRAMET." *Id.*

26 The rationale for why the specimen in this case, bearing **POM** constitutes  
27 acceptable use of POM is explained by the TTAB in *In re wTe Corporation*:  
28



1 We agree with applicant that when an applicant submits a standard character  
2 drawing it will often not be an ‘exact representation’ of the mark shown on  
3 the drawing because the very purpose of the typed or standard character  
4 drawing rule is to permit an applicant to apply for a mark without showing  
5 any particular style or design. *The mere fact that there is a design element  
associated with the word in the mark does not prevent an applicant from  
using a typed or standard character drawing.*

6 *In re wTe Corporation.* at \*3 (emphasis added). In fact, the USPTO has  
7 contemplated instances where the specimen/use in commerce is not identical to the  
8 standard character mark submitted for registration, yet it is appropriate use of the  
9 standard character mark:

10 The USPTO encourages the use of standard character drawings. As a general  
11 rule, an applicant may submit a standard character drawing when the word,  
12 letter, numeral, or combination thereof creates a distinct commercial  
13 impression apart from any stylization or design element appearing on the  
14 specimen. *If a mark remains the same in essence and is recognizable  
regardless of the form or manner of display that is presented, displaying the  
15 mark in standard character format affords a quick and efficient way of  
showing the essence of the mark.*

16 *In re wTe Corporation* at \*2 (emphasis added). Here, there is no reasonable  
17 possibility that the **POM** can be read as anything but POM, (*i.e.*, it cannot be read as  
18 P, heart design, M, just like the Board found that **Spectramet** cannot be read as  
19 anything but SPRECTRAMET). As the evidence demonstrates, no-one, including  
20 Hubbard himself, reads **POM** as anything but POM. (ASUMF 2). For this reason,  
21 time and again, a specimen showing the use of **POM** on a product has been accepted  
22 as an appropriate specimen for, and evidence of use of, the POM standard character  
23 mark. Because **POM** legally constitutes use of POM, the latter was never abandoned.

24 **D. The TTAB Cases Hubbard Cites Have Nothing To Do With**  
25 **Whether a Mark Should Be Cancelled for Abandonment Due To a**  
26 **Discrepancy Between The Mark As Used in Commerce And The**  
**Mark as Registered.**

27 Hubbard cites paragraph after paragraph to a handful of non-precedential  
28



1 cases,<sup>5</sup> for the general proposition that rights to a typed mark do not extend to  
2 include protection for those words combined with a design element or additional  
3 wording. (Motion at 6:16-9:4) However, every single one of these decisions and  
4 proceedings is factually and legally distinguishable.

5 None of those cases stand for the proposition that a difference between a  
6 standard character mark (POM) and the use of that mark with the incorporation of a  
7 stylization of a letter, (~~POM~~), or even a design in a letter, constitutes a basis for  
8 cancellation of that word mark due to non-use. Instead, all these cases evaluate the  
9 issue of “likelihood of confusion” between two competing marks. Each decision  
10 looks to whether an application for a new mark is confusingly similar to a mark that  
11 is already on the Register. Specifically, these cases turned on whether a word mark  
12 had rights over a mark with a design that was completely separate from the word  
13 mark and whether or not such a design created a wholly separate and distinct  
14 commercial impression from the word portion of the mark – an important  
15 distinction.

16 Hubbard’s cases all rely on and cite to a single sentence in *Fossil Inc. v.*  
17 *Fossil Group*, 49 USPQ2d 1451 (TTAB 1998). In *Fossil Inc.*, applicant sought to  
18 register the mark “FOSSILSCAPES THE FOSSIL GROUP STONESCAPES &  
19 Design” as shown here:



25 \_\_\_\_\_  
26 <sup>5</sup> *In re Sergio Abramof*, 2008 WL 853828 (TTAB 2008) (not precedent of TTAB);  
27 *In re Carinhoso Globo B.V.*, 2001 WL 256197 (TTAB 2001) (not precedent of  
28 TTAB); *In re NBA Properties*, 2000 TTAB LEXIS 863 (TTAB 2000) (not  
precedent of TTAB); *In re RealKidz Inc.*, 2010 TTAB LEXIS 247 (TTAB 2010)  
(not precedent of TTAB); *In re Ginc UK Ltd.*, 2001 WL 256197 (TTAB 2001).

1 *See Fossil, Inc.* at \*1. The trademark owner for the mark “FOSSIL” challenged this  
2 application. *Id.* at \*2. Under this factual scenario, the Board in *Fossil Inc.* noted  
3 that the FOSSIL trademark was not similar enough to applicant’s, given the  
4 additional wording in applicant’s proposed mark (FOSSILSCAPES, THE, GROUP,  
5 and STONESCAPES) or designs (circular design, shells etc.).

6 Moreover, the portion of the opinion cited by Hubbard has to do with whether  
7 Fossil Inc.’s word mark “FOSSIL” provided “rights in the word FOSSIL combined  
8 with other wording or designs.” *Id.* at 1454. The design at issue is:



12 “Hence opposer’s registrations of FOSSIL per se in typed drawing do not  
13 encompass opposer’s alleged mark AUTHENTIC FOSSIL GENUINE and oval  
14 design.” *Id.* It is no stretch to conclude that the word mark FOSSIL, by itself  
15 cannot encompass the entirety of the design above.

16 Similarly, in *In re NBA Properties, Inc.*, applicant wanted to register the mark  
17 CAPS which also contained a separate design element which looked like the U.S.  
18 Capitol building:



22 *See In re NBA Properties, Inc.*, at \*1. The standard character mark KAPS was  
23 already on the register. In this context, the Board appropriately held that KAPS was  
24 not similar to and could not stop use of the U.S. Capitol building design.

1 Also in *In re Ginc UK Ltd.*, the issue was whether applicant's ZOGGS  
2 TOGGS was confusingly similar to the mark:



6 See *In re Ginc UK Ltd.*, at \*2. Again, given that the applicant's mark had a star and  
7 circle design element which was completely separate and apart from the typed  
8 drawing, it stood to reason that "the term ZOGG TOGGS would not extend to  
9 include protection for those words combined with a design element." *Id.* at fn.7.  
10 (Notably, despite this general rule, the Board still found likelihood of confusion  
11 between the marks and refused registration.).

12 In *In re Sergio Abramof*, applicant sought to register SERGIO's as a standard  
13 character mark. *Id.* at \*1. The issue was whether SERGIO's was confusingly  
14 similar to:



19 *In re Sergio Abramof* at \*2. The general rule that the standard character mark  
20 SERGIO's could not extend to include protection for the design of a person wearing  
21 a sombrero and carrying food, was obvious and made logical sense.

22 In *In re Carinhoso Globo B.V.*, applicant sought to register OPPUS as a  
23 standard character mark. *Id.* at \*1. The issue was whether OPPUS was confusingly  
24 similar to:



27 Once again, it was clear in this case that the word mark OPPUS had no rights  
28 to a drawing of an opossum, and could not prevent its registration.

1 Finally *In re Realkidz, Inc.*, directly contradicts Hubbard’s position. In that  
2 case, applicant sought to register the following two marks:



6 See *In re Realkidz, Inc.* at \*1. Opposer owned FOR REAL KIDS in typed form.  
7 Despite the design element in the proposed marks, the Board still refused  
8 registration because “the marks as whole create similar commercial impressions” as  
9 the standard character marks. *Id.* at \*4.

10 **E. This Court Should Not Second Guess The Trademark Examiner’s**  
11 **Acceptance of The POM Specimen As Appropriate Use of the**  
**POM® Mark**

12 The USPTO is charged with granting trademark rights and the USPTO has  
13 continually accepted POM as a proper specimen for POM, just like it has accepted a  
14 variety of design marks cited above as appropriate use of the standard character  
15 marks. Hubbard claims that the TTAB is not bound by the acceptance of specimens  
16 by the Examining Attorneys. (Motion 10:28-11:2). By extension he suggests that  
17 this court shouldn’t either. While it may be true that the TTAB is not bound by its  
18 Examining Attorney’s decisions, the TTAB is cautious in its review of an  
19 Examiner’s judgment. “We have previously stated that it is not the Board’s function  
20 to review the work of the Examiner.” *Century 21 Real Estate Corp. v. Century Life*,  
21 10 USPQ.2d 2034, \*1 (TTAB 1989). “We are not going to substitute our judgment  
22 for that of the Examiner, on the same facts that were before the Examiner, unless we  
23 are convinced that clear error was committed.” *Id.* Hubbard is asking for this court  
24 to second guess the USPTO Examining Attorney’s decision that POM is an  
25 appropriate specimen for and use in commerce of POM, and potentially find that  
26 such use amounted to no use at all. The law does not support Hubbard’s position.  
27  
28

**F. The Concept of “Tacking” Has No Application To This Case**

Hubbard spends a good portion of his brief arguing that “POM Wonderful’s attempt to ‘tack’ the use of its other marks to the ‘053 Registration fails....” (Motion 17:1-2). POM Wonderful has never argued that it is attempting to tack any trademark to any other trademark. Either Hubbard does not know what tacking is or he, again, is using an inapplicable legal concept as a red herring. Thomas McCarthy explains this concept in his treatise. Generally, tacking is when a business decides to make changes in the format of their trademark over a period of years. *McCarthy on Trademarks* § 17:25. For example, IBM’s original trademark looked like this:



But over the years it has evolved and now it looks like this:



*Id.* Such change in trademarks could be attacked on the grounds of abandonment of rights in the old form and that the change prevents the user from tracing priority of use back to a date of first use of the old form of the trademark. *See Id.* “Another way to state the priority issue is the trademark owner’s ability to ‘tack on’ the prior use of the old format to the use of the new format to achieve priority of use over a rival.” *Id.* Here, there is no dispute that POM Wonderful obtained its trademark rights long before Hubbard’s use of pōm. Therefore, priority of rights is not at issue, and tacking has no application to this case. Furthermore, POM is not the old form of Pōm or vice versa. Both marks were in use within months of each other. (See registrations of the two marks attached as Exhibit A to Vasseghi Decl.) Therefore it is unnecessary for POM Wonderful to try and tack the rights of one mark onto the later registered one.

**G. The Cancellation or Abandonment of The POM® Mark Does Not Eliminate POM Wonderful's Trademark Infringement Claim**

Hubbard wrongly believes that if his motion were to be granted, it would undermine or somehow negate POM Wonderful's infringement claims against him. He is wrong. POM Wonderful's infringement claim would still survive since pōm also infringes on and is likely to be confused with POM. In fact when the Ninth Circuit analyzed the marks for determining similarity, it considered the marks as they appeared on the products themselves:

Turning first to the appearance of the "POM®" mark on the left and the "pōm" mark on the right, the marks possess many obvious visual similarities.



Most significantly, each mark is comprised of the same three letters. These three letters are presented in the same order, with a stylized second letter (i.e., the "o" in "POM" is heartshaped, and the "o" in "pom" has a breve over it). In addition, the letters in both marks are uniformly cased (i.e., they are either all uppercase, or all lowercase) and presented in a simplistic, white font that is offset by a dark maroon background.

*Pom Wonderful LLC v. Hubbard*, at 1128-1130 (9th Cir. 2014) (images part of original opinion).

Hubbard's pōm mark infringes both POM and POM. Abandonment of POM does not relieve Hubbard of trademark infringement.

**H. Hubbard Has Created Triable Issues of Material Fact**

Hubbard spends the majority of his motion arguing that the use of the POM mark on POM Wonderful's websites does not amount to proper trademark use of the mark.

As an initial matter, whether or not POM Wonderful's use of its POM mark on its website was sufficient trademark use, is irrelevant for purposes of defeating Hubbard's motion, since POM Wonderful has established that it has always used



1 and continues to use its POM trademark on its products in the form of POM and that  
2 such use is proper as a matter of law.

3 To the extent the court concludes that POM Wonderful has not opposed  
4 Hubbard's motion, by establishing non-abandonment of the POM mark as a matter  
5 of law, then the fact of use or non-use of POM on its websites creates a triable issue  
6 of material fact.

7 The TTAB utilizes a three-prong test to determine if the content of a web  
8 page sufficiently constitutes trademark use: whether "(1) it includes a picture of the  
9 relevant goods; (2) it shows the mark sufficiently near the picture of the goods to  
10 associate the mark with the goods; and (3) it includes the information necessary to  
11 order the goods, (e.g., a phone number, mailing address, or e-mail address)". *In re*  
12 *Dell, Inc.*, 71 U.S.P.Q.2d 1725 (TTAB 2004); *In re Genitope Corp.*, 78 U.S.P.Q.2d  
13 1819, 1822 (TTAB 2006). Pom's websites meet all three criteria as shown here:



20 (ASUMF 3; Exhibit R to Hubbard's Request for Judicial Notice, POM-PUR 1-  
21 12,14-20, 22-25, 31).

22 Hubbard also argues that the use of POM in those websites and others is not  
23 trademark use because "it describes the nature of the product rather than the source  
24 of the product." (Motion 14:14-16). However, Hubbard offers no evidence in  
25 support of his personal opinion. In fact, his guess at what POM Wonderful's use of  
26 the POM mark signified, is contradicted by POM Wonderful's Director of  
27 Marketing who testified that in instances where POM is used on the website, it does  
28 not refer to pomegranates, but rather, it refers to the POM Wonderful brand of 100%



1 pomegranate juice. (ASUMF 4). Since Hubbard argues that POM Wonderful has  
2 abandoned its POM trademark because its use of POM® on its website is improper,  
3 there is a factual dispute over that issue, which must necessarily defeat his motion.

4 Hubbard also claims that POM cannot establish specific sales amounts from  
5 its website. However, POM Wonderful has provided Hubbard with its sales data  
6 since 2002. Additionally, as Hubbard concedes, POM Wonderful has provided  
7 information for the amount of its website sales from 2008 onwards. While POM  
8 Wonderful may not have specific data relating to the amount of sales made online  
9 prior to 2008, there is, at a minimum, a factual dispute as to whether such sales  
10 occurred.

11 Finally, Hubbard's arguments – that POM as part of the URL or corporate  
12 name does not constitute proper trademark use, is just a wasted effort. POM  
13 Wonderful does not contend that it does, and in any case, all the uses Hubbard  
14 claims to constitute non-use (website, corporate name, URL) do not alter the fact  
15 that POM has been in use as a matter of law because it has been continuously  
16 depicted on the company's products since 2002. (ASUMF 1).

### 17 **III. CONCLUSION**

18 For the foregoing reasons, Pom Wonderful respectfully requests that  
19 Hubbard's Motion be denied, and that its cross motion for summary judgment on its  
20 claims and summary adjudication on Hubbard's defenses, including abandonment,  
21 be granted.

22 DATED: May 27, 2016

ROLL LAW GROUP PC

23 By: /s/ Michael M. Vasseghi

24 Michael M. Vasseghi

25 Attorneys for Plaintiffs

26 POM WONDERFUL LLC, and THE  
27 WONDERFUL COMPANY LLC  
28